

**REMARKS**

Claims 1-5 are pending in this application, with Claim 1 being independent. Without prejudice to or disclaimer of the subject matter contained therein, Claims 13-22, have been canceled. Applicants reserve the right to pursue any canceled subject matter in one or more continuation or divisional applications.

Reconsideration of the outstanding rejections in view of the following remarks is respectfully requested.

**CLAIM REJECTION UNDER 35 U.S.C. §103(a)**

Claims 1-5 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,997,691 ("Gautam"). The reasons for the rejection are stated on pages 3-4 of the Official Action. This rejection is respectfully traversed.

Specifically, the Official Action asserts,

The only difference between the claimed invention and Gautam et al. invention is that the way in which the add-on material is ground, i.e., Gautam et al. teach a wet grinding process, while the present application teaches the dry comminution of the add-on materials. However, using either process of grinding is within the levels of ordinary skill in the art, since both of them are very well known in the art. Note that if one desires to do the dry grinding operation, then the steps of pressing and drying the slurry are [] necessary and also very well known in the dry market pulp. Wet and dry grinding are functional equivalent processes. . . . (Page 4)

However, as explained in the present specification, "dry grinding" results in add-on material having a very narrow range of cellulose fiber sizes, and as a result the areas of the cigarette paper having the add-on material provide consistent and predictable performance; the add-on material is produced in much shorter time and with consumption of less energy than would be required to produce similar add-on material having a comparably narrow range of fiber sizes using techniques wherein a wet slurry material is repeatedly refined using multi-disk refiners. (Page 3, Paragraph [0010]).

Accordingly, the Official Action does not provide any factual basis for the assertion that wet and dry grinding are functionally equivalent processes with regards to the production of producing add-on material, a pattern of which is to be applied across a base width of cigarette paper.

As Applicants have challenged a factual assertion of the Official Action as not properly officially noticed or not properly based upon common knowledge, the Examiner is requested to provide documentary evidence in the next Official Action if the rejection is to be maintained. See 37 CFR § 1.104(c)(2); MPEP § 2144.03.C

Rebuttal of a *prima facie* case of obviousness is merely "a showing of facts supporting the opposite conclusion." *In re Heldt*, 433 F.2d 808, 167 USPQ 676 (CCPA 1970). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990); MPEP § 2142. "If rebuttal evidence of adequate weight is produced, the holding of *prima facie* obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated. Regardless of whether the *prima facie* case would have been characterized as strong or weak, the examiner must consider all of the evidence anew." *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

Claim 1 recites a method of manufacturing a web having an applied pattern of add-on material comprising: moving a base web along a first path; preparing a slurry of add-on material; and repetitively discharging the slurry of add-on material upon the moving base web. The step of preparing a slurry of add-on material includes: cooking a fibrous cellulosic material, bleaching the material, pressing the cooked and bleached material to remove liquid, drying the pressed material, milling the dried material to produce fibers of a desired size, and mixing the milled material with water to hydrate the material and produce a slurry.

As explained above, "dry grinding" results in add-on material having a very narrow range of cellulose fiber sizes, and as a result the areas of the cigarette paper having the add-on material provide consistent and predictable performance; the add-on material is produced in much shorter time and with consumption of less energy than would be required to produce similar add-on material having a comparably narrow range of fiber sizes using techniques wherein a wet slurry material is repeatedly refined using multi-disk refiners.

While it is respectfully submitted that a *prima facie* case of obviousness has not been established, it is further respectfully submitted that the improved results and

more economical process associated with "dry grinding" in the claimed method, as compared to "wet grinding", rebuts any possible *prima facie* case of obviousness.

Applicants again respectfully note that the newly claimed combination of steps provides important advantages, including, as outlined in the present specification, for example, better control of fiber length of the add-on material, which provides a more consistent and predictable performance of the banded paper (Page 3, Paragraph [0010], Lines 4-7), and savings in time and energy consumption during manufacturing operations (Page 3, Paragraph [0010], Lines 7-9, and at Page 6, Paragraph [0017]). Accordingly, the claimed combination both enhances the ultimate product and presents a novel combination of steps of making the ultimate product. Applicants respectfully submit that the claimed combination of steps and the advantages thereof are neither taught nor suggested by the prior art of record.

Accordingly, withdrawal of the rejection is respectfully requested.

## CONCLUSION

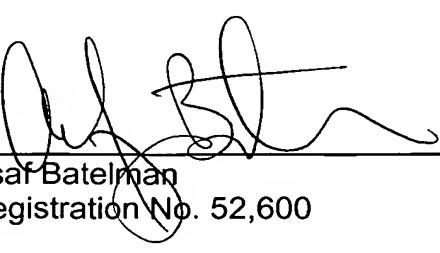
From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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